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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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08/976,886 11/24/97 RIMM

D H-1296

HM22/0705

WILLIAM W JONES
6 JUNIPER LANE
MADISON CT 06443

EXAMINER

CHIN, C

ART UNIT

PAPER NUMBER

1641

14

DATE MAILED:

07/05/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

| | | |
|------------------------------|--------------------------------------|-----------------------------------|
| Office Action Summary | Application No. 08/976,886 | Applicant(s) Rimm et al |
| | Examiner Chris Chin | Group Art Unit 1641 |

Responsive to communication(s) filed on Apr 13, 1900.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-7 and 9-14 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-7 and 9-14 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Continued Prosecution Application

1. The request filed on 4/13/00 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/976,886 is acceptable and a CPA has been established. An action on the CPA follows.

Specification

2. The use of the trademark DAPI and SYTO (pages 7 and 8) has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 U.S.C. § 112

3. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 14 is vague. The claim recites the use of labeling agents (line 6) which produce a “characteristic signal result on cancer cells” but the claim goes on to say that the signal result can include no signal at all. The function of the labeling agent is to produce a signal result so it is not possible for the labeling agent to not produce a signal.

4. Claims 3-7, 9, and 13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 3-7, 9, and 13 have been amended to recite “an at least partially transparent container” which is considered to be new matter that is not supported by the originally filed specification. The originally filed specification does not provide any literal support or suggestion of a partially transparent container in which the disclosed methods are to be performed. Applicants are advised to point to specific section(s) of the specification that provide support for this limitation.

Claim Rejections - 35 U.S.C. § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-7 and 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levine et al (U.S. Patent 5,834,217) in view of Nagy et al and Goldblatt et al for the reasons of record.

In response to the Levine et al reference, applicants argue that the cited references (especially Levine et al) are not directed to the detection of individual cells. Applicants argue that Levine et al is directed to the “quantitation of target cell bands”.

Applicant’s argument has been considered but is not convincing because the instant claims do not recite the detection of individual cells. None of the instant claims recite any limitations that limit them to the detection of individual cells. The preambles of all of the claims refer to detection of cells which would include the cell bands taught by Levine et al.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris Chin whose telephone number is (703) 308-3991. The examiner can normally be reached on Monday-Thursday from 9:30 am to 7:00 pm. The examiner can also be reached on alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le, can be reached on (703) 305-3399. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

cchin/cc
July 3, 2000



CHRISTOPHER L. CHIN
PRIMARY EXAMINER
GROUP 1800-1641